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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,793	11/21/2003	Edward Paul Carlin	9434	2943

27752 7590 04/18/2006

THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
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CINCINNATI, OH 45224

EXAMINER

HAND, MELANIE JO

ART UNIT PAPER NUMBER

3761

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,793	<b>Applicant(s)</b> CARLIN, EDWARD PAUL	
	<b>Examiner</b> Melanie J. Hand	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
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- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/1/06</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed February 1, 2006, with respect to the non-statutory double patenting rejection of claims 1,2 and 8-12 are moot in view of the filing of a terminal disclaimer on February 1, 2006.

Applicant's arguments with respect to the rejection(s) of claim(s) 1 and 3-9 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly found prior art reference.

### ***Terminal Disclaimer***

The terminal disclaimer filed on February 1, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 10/749,258 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on February 2, 2006 was filed after the mailing date of the Application on November 21, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2 and 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoelling (U.S. Patent Application Publication No. 2002/0151859).

With respect to **Claims 1,2,5**: Schoelling discloses a tampon made of compressed fibrous material with an insertion end, a recovery end, a longitudinal axis, and an outer surface with longitudinally extending ribs. The longitudinally extending ribs approaching the insertion end define a width x closest to tip of the tampon, and a width y (smaller than x) as the width of the grooves decreases. By teaching a largest width at one end and a smallest width at a second opposing end, Schoelling is teaching a width dimension of said raised portions that varies continuously along the length of each said raised portion. (¶ 0009)

With respect to **Claim 7**: As can best be seen in any of Figs. 1-5, said longitudinal raised portions are evenly spaced from one another.

With respect to **Claims 8,9**: The tampon taught by Schoelling can either have a uniform density over a cross-section or ribs that extend radially outward from a centrally positioned core, producing a cross-section that exhibits a varying density. (¶ 0009)

With respect to **Claim 10**: The tampon taught by Schoelling has a highly compressed core. (¶0009)

With respect to **Claims 11,12**: Schoelling teaches recovery tape 35. (¶ 0075)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoelling ('859).

With respect to **Claim 3**: Schoelling does not teach that the largest width dimension is located in the withdrawal end. Examiner asserts that it would be obvious to one of ordinary skill in the art to modify the tampon taught by Schoelling such that the largest width dimension of the raised portions is located in the withdrawal end. Such a modification would be achieved by disposing the withdrawal member on the longitudinally opposite end from where it currently resides, and such a rearranging of the structural elements does not render claim 3 patentable over the prior

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art of Schoelling. It has been held that rearranging elements of an invention involves only routine skill in the art. See *In re Japikse*, 86 USPQ 70 (CCPA 1950)

With respect to **Claims 4,6**: Schoelling does not teach that a central region of the tampon, and thus a central region of each raised portions, defines the smallest width along the length of any of said raised portions. Examiner asserts that since applicant has not assigned any criticality to this limitation, such a limitation is an optimization of the width trend along the length of said raised portions and thus it would be obvious to one of ordinary skill in the art to modify the width trend such that the portion of each raised portion having the smallest width (when compared to other portions) is located in a central portion of the tampon as a whole. Such a modification would result in a width dimension of said raised portions that varies intermittently along the length of each said raised portion. It has been held that where general conditions of claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation. See *In re Aller, Lacey and Hall* (105 USPQ 233, CCPA, 1955).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie J Hand  
Examiner  
Art Unit 3761

MJH

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER



**Office Action Summary**

Application No.

10/719,793

Applicant(s)

CARLIN, EDWARD PAUL

Examiner

Chivonne L. Evans

Art Unit

3761

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Paper No(s)/Mail Date 1-3/25/2004
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_



## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by <sup>add central</sup> Hirschman (3690321). <sup>region etc.</sup> With regards to claim 1 and 7, Hirschman discloses a catamenial device such as a tampon with longitudinally extending (length dimension) circumferentially (evenly) spaced grooves with a width varying cross-section as shown in figure 5 and disclosed in Column 2, lines 30-39. With respect to claims 3 and 4, Hirschman also reveals in Figure 5 a withdrawal end that has the largest width dimension and a center region with the smallest width dimension. With respect to claims 5 and 6, Hirschman discloses a width that varies continuously whereas there are no gaps or attachments along the length of the catamenial device, and intermittently along the length whereas the regions such as those shown in Figure 5- (11, 24, 12) are considered intervals along the length of the catamenial device. (Figure 5, and Column 2, lines 21-Column 3, line 7) With regards to claims 8 and 9, Hirschman reveals in Figures 1 and 3 a device where the density is varied over a cross-section and is uniform over a cross-section, respectively.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-2 and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 7-11 of copending Application No. 10749258. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims raised portions in the insertion end (claim 2) with a width x and width y whereas the width x is larger than the width y, corresponding with the claims 1 and 2 of this application. Also, with respect to claim 1, it is inherent that the raised portions have a "length" dimension as well as the tampon having a center region. Claims 8-12 are correspond with claims 7-11, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wasson (2005/0027275), Randall (2003/0176844), Lochte (6758839) and Sheldon (4650459) are all relevant to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chivonne L. Evans whose telephone number is 571-272-8686. The examiner can normally be reached on between 6:30-3:30, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Chivonne L. Evans  
Examiner  
Art Unit 3761

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TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER  
